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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,499	12/22/1999	TAKAYUKI SUGAHARA	041-1790B	5038

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EXAMINER	
LEE, Y YOUNG	
ART UNIT	**PAPER NUMBER**
2613	

DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/469,499	Applicant(s) Takayuki Sugahara
	Examiner Y. Lee	Art Unit 2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Jul 5, 2001*

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-22 and 28-47* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-22 and 28-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☒ The proposed drawing correction filed on *Nov 13, 2000* is: a)☒ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☒ All b)☐ Some* c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/940,941*.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)

16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18)☐ Interview Summary (PTO-413) Paper No(s). _____

19)☐ Notice of Informal Patent Application (PTO-152)

20)☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Figure 15 in Paper No. 15 is acknowledged.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/940,941, filed on 9/30/97.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11/13/00 have been approved.

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 18-22 and 28-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilbel (5,214,556) in view of Abecassis (5,434,678) for the same reasons as set forth in Section 7 of the last office action, paper number 15, dated 4/2/01.

With respect to the newly amended and newly added claims 38-47, the protection data of Abecassis are specific to each of one or more predetermined regions 311 within each of a sequence of one or more predetermined sequential frames 304 of the video signal 301.

Response to Arguments

7. Applicant's arguments filed 7/5/01 have been fully considered but they are not persuasive.

In response to applicant's argument on page 17 of the Remarks that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., implementing a particular form of degradation of an existing data stream during reproduction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant asserts on pages 13-21 that Abecassis does not apply any form of reproduction protection processing. However, Figures 2 and 3 of Abecassis illustrate that the main data 301 is

reproduced with variable reproduction protection (319, 329, 339) by applying reproduction protection to the process of reproducing an existing entertainment item 303 at position 3ii.

In response to applicant's argument on pages 21 and 22 of the Remarks that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, even if suggestion for combination is not particularly specified in either Kilbel or Abecassis, the question in the test for combining references in a section 103 rejection is not solely relied on what the individual reference expressly teaches. In re McLaughlin, 170 USPQ 209-213:

> "It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper."

Therefore, even though neither Kilbel nor Abecassis taken singularly for claims 18-22 and 28-47 suggests the combination as claimed, the combination of Kilbel and Abecassis taken as a whole

would have been obvious to one of ordinary skill in the art as previously set forth in the last office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED PROCEDURE")

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Or:

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

Y. LEE
PRIMARY EXAMINER

Y. Lee/yl
April 30, 2002